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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/990,702

11/09/2001

Keith W. Diveley

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12/13/2004

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EXAMINER

REAGAN, JAMES A

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,702

Applicant(s)

DIVELEY, KEITH W.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 38-49 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-31 and 38-49 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 22 September 2004.
2. Claims 1, 3-5, 8, 10, 12-14, 16, 19, and 22-31 have been amended.
3. Claims 32-37 have been cancelled.
4. Claims 38-49 have been added.
5. Claims 1-31 and 38-49 are pending and have been examined.

RESPONSE TO ARGUMENTS

6. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 8-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch (US 5,903,633 A) in view of O'Mahony et al., "Electronic Payment Systems" (1997).

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 1, 40, 43-45, 48, and 49:

Lorsch, as shown, discloses the following limitations:

- *a payment service provider receiving a set of identifiers from a consumer provider that are associated with a good or a service of the consumer provider (see at least column 1, lines 29-31);*
- *the payment service provider receiving a request from a customer of the consumer provider to pay for the good or the service, wherein the request includes one of the identifiers and a payment (see at least column 8, lines 34-39);*

Lorsch does not specifically disclose:

- *creating an electronic record of the payment the customer information and the identifier, and*
- *electronically sending the electronic payment record to the consumer provider.*

However, Lorsch, in at least column 8, lines 40-62 discloses adding minutes to the phone card using a POS device, paying for the minutes, debiting the clients checking account, and recording the transaction on a database, essentially disclosing the limitations aforementioned. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the prepaid phone card activations and billing method of Lorsch because it provides an efficient and secure method of offering a simple communication system to a consumer.

Lorsch does not specifically disclose a payment service provider. O'Mahony, in chapter 7 of his book fully discloses micropayment systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the payment techniques of Lorsch with O'Mahony's micropayment technique because it provides both the consumer and the service provider with a third party that excels in providing safe and secure payment systems.

Claims 2, 41, 42, and 46:

Lorsch does not specifically disclose *electronically transferring the payment to a bank account of the consumer provider*. However, Lorsch does disclose debiting the clients checking account. Naturally, the amount debited would be credited to the providers account.

Claims 3, 8, 9, 14, 23, 30, and 47:

With regard to the limitations of:

- *sending information from the electronic record to a switch that is configured to add minutes to a cell phone number based on the information wherein the information identifies a cell phone number associated with the customer;*
- *the identifiers are associated with stored value cards, wherein the request to pay for the service comprises a request to pay for one of the*

stored value cards, and wherein receipt of the electronic record is used to activate the stored value card;

- *the stored value card includes phone time;*
- *a switch in communication with the host computer, wherein the switch is configured to add phone time to a phone number upon receipt of the identifier, the customer information, payment information from the host computer, and wherein the customer information identifies the phone number;*
- *the service comprises phone service, and further comprising adding time to the phone upon presentment of the identifier to the consumer provider;*
and
- *the service comprises phone service, and further comprising activating a phone upon presentment of the identifier to the consumer service provider.*

See Lorsch, in at least column 8, lines 40-62, and the rejection of claim 1 above.

Claim 4:

With regard to the limitation of *the request is entered into a terminal having a processor, and wherein the electronic record is transferred electronically from the terminal to a host computer*, see Lorsch, in at least column 8, lines 40-62, and the rejection of claim 1 above.

Claim 5:

With regard to the limitation of *the electronic record is further transmitted from the host computer to the consumer provider*, Lorsch effectively discloses payment records and receipts being processed, sent, and stored on the centralized computer, invoice computer, and central database in at least Figure 1 and associated text.

Claim 6:

With regard to the limitation of *the set of identifiers are associated with enrollment information obtained from consumers enrolling with the consumer provider, and further comprising electronically sending enrollment information from the consumer provider to the host computer*, Lorsch discloses activation of the card in at least column 1, lines 8-12, essentially disclosing enrolling the card and card user based upon the account and PIN of the phone card.

Claim 10:

With regard to the limitation of *at least some part of the identifier is associated with a payment amount as determined by the consumer provider*, Lorsch, in at least column 1, lines 41-48, discloses an account number associated with a predetermined talk time.

Claim 11:

With regard to the limitation of *the payment amount is for a good offered by a consumer provider over the television*, the Examiner takes **Official Notice** that it is old and well known in the arts to advertise on television because it reaches many consumers.

Claim 12:

With regard to the limitations of:

- *a host computer; and*
- *a database associated with the host computer,*
- *the database having a record of a set of identifiers that are associated with a consumer provider;*
- *wherein the host computer is configured to receive a record containing one of the identifiers along with information on a payment and information about a customer to send information from the record to the*

consumer provider, and to electronically facilitate the sending of the payment to a bank of the consumer provider;

See the rejections of claims 1 and 2 above.

Claim 13:

With regard to the limitations of *at least one terminal having a processor that is capable of communicating with the host computer, and wherein the terminal is configured to receive the identifier, the customer information and payment information and to transmit the identifier, the customer information, and the payment information to the host computer*, see the rejections of claims 4 and 5 above.

Claims 15, 21, 28, and 36:

With regard to the limitations of:

- *a printer coupled to the terminal to print a receipt showing the payment;*
- *the receipt comprises a sheet of paper having the identifier printed thereon;*
- *the identifier is issued on a receipt comprising a sheet of paper having the identifier printed thereon; and*
- *producing a receipt having an identifier that indicates payment has been made;*

Lorsch discloses a POS terminal in at least Figure 1, plainly disclosing a printing device that prints the transaction and relevant transaction data such as account numbers and payment amounts.

Claim 16:

With regard to the limitations of:

- *a payment service provider contracting with a consumer provider to provide payment services to the consumer provider's customers, wherein a customer of the consumer provider makes a payment to the payment service provider to obtain a good or a service from the consumer provider;*
- *the payment service provider receiving a set of identifiers from the consumer provider that are presentable to the consumer provider to receive the good or the service from the consumer service provider, wherein the identifiers are active and do not need activation by the consumer provider prior to issuance to the customer;*
- *receiving a request to pay for the good or the service along with a payment;*
- *associating the payment with one of the identifiers;*
- *creating an electronic record of the payment along with the associated identifier; and*
- *issuing a receipt that includes the identifier, wherein the identifier is presentable to the consumer provider to receive the good or the service;*
- *communicating the electronic record to the consumer provider.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

Claim 17:

With regard to the limitation of entering information on the payment into a terminal having a processor and that contains a record of the associated identifier, see the rejection of claim 1 above.

Claim 18:

With regard to the limitation of *sending the payment information and the associated identifier from the terminal to a host computer*, see the rejection of claim 1 above.

Claim 19:

With regard to the limitation of *sending the payment information and the associated identifier from the host computer to the consumer provider*, see the rejection of claim 2 above.

Claim 20:

With regard to the limitation of *each identifier is associated with a fixed payment amount*, the Examiner takes **Official Notice** that it is old and well known in the credit card arts to require a minimum monthly payment because this ensures that the consumer can make a reasonable payment to the credit card company as well as ensuring positive monthly cash flows.

Claim 22:

With regard to the limitation of *sending the payment to a bank account of the consumer provider, and sending payment information along with the associated identifier to the consumer provider*, see the rejection of claim 2 above.

Claim 24:

With regard to the limitations of:

- *a terminal having an input device and a printer;*
- *a host computer maintained by a payment service provider having a record of identifiers that are associated with a good or a service of a consumer provider, wherein the identifiers are active;*
- *wherein the terminal is capable of communicating with the host computer to receive the identifiers, of receiving payment information using the input device, of associating one of the identifiers with the payment information, and to send payment information and the associated identifier back to the host computer, and*
- *wherein the terminal is configured to print a receipt with the identifier.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

Claims 25 and 39:

With regard to the limitations of:

- *a customer establishing an account with a consumer providers wherein the customer provides information to the consumer provider to establish the account, and wherein the account requires a payment for service activation;*
- *the payment service provider electronically receiving account information from the consumer provider;*
- *entering payment information into a terminal and creating an electronic record of the payment; and*
- *issuing an identifier to the customer that is presentable to the consumer service provider to activate the service;*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

With regard to the limitation of *the account information including a required payment for service activation, and the payment service provider receiving a request from the customer to make the required payment along with the payment*, the Examiner takes **Official Notice** that it is old and well known in the credit card arts to pay a nominal up front administrative, processing, or activation fee. Front-loading fees assures that credit card companies recoup at least a portion of the operating costs immediately.

Claim 26:

With regard to the limitation of *sending the payment information and the associated identifier to a host computer*, see the rejections of claims 1 and 2 above.

Claim 27:

With regard to the limitation of *sending the payment information and the associated identifier from the host computer to the consumer provider*, see the rejections of claims 1 and 2 above.

Claim 29:

With regard to the limitation of *sending the payment to a bank account of the consumer provider, and sending payment information along with the associated identifier to the consumer provider*, see the rejections of claims 1 and 2 above.

Claim 31:

With regard to the limitations of:

- *a terminal having an input device and a printer;*
- *a host computer maintained by a pavement service provider capable of receiving a service activation account information provided by a consumer provider and an associated identifier, wherein the service activation account information identifies an account a customer has established with the consumer provider;*
- *a storage medium for storing a record of the identifier;*
- *wherein the terminal is capable of communicating with the host computer to receive the service account information and the associated identifier, of receiving payment information using the input device, of associating the identifier with the payment information, and to send payment information and the associated identifier back to the host computer, and wherein the terminal is configured to print a receipt with the identifier; and*
- *wherein the identifier is presentable to the consumer service provider to activate the service.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 25, 28, and 36 above.

Claim 38:

Lorsch discloses the limitations of claims 1 and 2 above. Lorsch does not specifically disclose the consumer information comprises at least one of a name, a social security number, and address, and a telephone number associated with the customer. However, the Examiner takes **Official Notice** that it is old and well known in the credit card arts to provide personal information because this allows for positive identification of credit participants.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch in view of Vulcan et al. (US 5,799,072 A).

Claim 7:

Lorsch discloses the prepaid phone card activations and billing method as shown above in the rejection of claim 1. Lorsch does not specifically disclose *periodically receiving updated enrollment information at the host computer*. Vulcan, however, in at least the abstract and other associated text discloses updating a client database on a regular basis, essentially disclosing that personal and account information regarding prepaid phone cards and their users is also easily updated. It would have been obvious to one of ordinary skill in the art at the time of the invention to regularly update their client database because this maintains current contact and billing formation.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

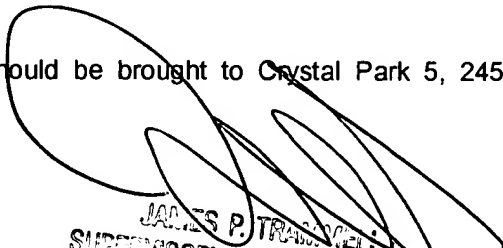
(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

07 December 2004


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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